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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/584,975 | 06/30/2006 | Klaus Steinhauser | ZAHFRI P868US | 2444 |
| 20210 7590 07/20/2010 DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301 | | | | |
| EXAMINER | | | | |
| KNIGHT, DEREK DOUGLAS | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3655 | | | | |
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| 07/20/2010 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,975

Applicant(s)

STEINHAUSER ET AL.

Examiner

DEREK D. KNIGHT

Art Unit

3655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 21, 22, 24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 21, 22, 24, 26-28 and 31-33 is/are allowed.
- 6) ☒ Claim(s) 29, 30 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 24 and 26-33 are objected to because of the following informalities:

Claim 24, line 7 recites "motor firing", this should read --motor fueling--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method which a) commands additional motor fueling, b) engages a switching element, and c) disengages a different switching element does not reasonably provide enablement for a step of forgoing additional motor fueling to disengage the switching element being disengage for controlling the pressure for engagement of the switching element being engaged. The specification also does not reasonably provide enablement for a step of either transferring additional motor fueling for disengaging the switching element being engaged or considering the additional motor fueling for controlling pressure for engaging the switching element being engaged. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. Both claim 29 and 30 contain limitations

which are not disclosed in the specification. They are also written in a way that is confusing and unclear to the Examiner. The Examiner believes the Applicant is attempting to claim the subject matter found in paragraphs [033] - [035] of the specification, if this is the case Examiner suggest using language that clearly expresses those limitations found in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 29: It is unclear to the Examiner how foregoing additional motor fueling causes disengagement of the switching element. It is also unclear how controlling the pressure for engagement of the switching element being engaged is effected by foregoing additional motor fueling.

Regarding claim 30: It is unclear to the examiner how additional motor fueling is used for disengaging the switching element being engaged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by **POPP et al.**
(US 6,375,597).

Regarding **claim 34**, POPP discloses a method for increasing a spontaneity of an overlapping shifting operation in an automatic transmission, the method comprising the steps of; issuing an overlapping switching command to a transmission controller (Fig. 5A); transmitting a command from a transmission controller to a motor controller for increasing motor fueling directly after transmission of the overlapping switching command (Fig. 5B); setting a rotational speed and a motor torque as a function of a desired increase in spontaneity (point C, B, or D); fueling the motor depending on either the set rotational speed or the set motor torque to be utilized by the automatic transmission; fueling the motor up to a maximum attainable full-load characteristic curve (one of the three curves in Fig. 5B); and at least one of forcing open a switching element being disengaged (Fig. 5C) and increasing a rotational speed gradient (turbine rotational speed) by the fueling of the motor.

Allowable Subject Matter

Claims 14, 21, 22, 24, 26-28 and 31-33 are allowed.

Response to Arguments

Applicant's arguments filed 4/27/2010 have been fully considered but they are not persuasive. Applicant's arguments regarding claim 34 are not persuasive. Applicant

states that the amended claim recites similar limitations as those found in amended claim 14, however, claim 34 is lacking the specific limitation of "adjusting engagement and disengagement of the transmission clutches depending on the increase in fuel supplied to the engine or a resultant increase in the motor output torque to the transmission during the gear shift".

The amendments to claim 14 distinguish is from the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEREK D. KNIGHT whose telephone number is (571)272-7951. The examiner can normally be reached on Mon - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D. K./
Examiner, Art Unit 3655

/David D. Le/
Primary Examiner, Art Unit 3655
07/18/2010